

PATENT
2569-103P



IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of
Wells OBRECHT

Before the Board of Appeals
Appeal No.:

Appl. No.: 08/900,360

Group: 2765

Filed: July 25, 1997

Examiner: MEINECKE DIAZ,

Conf.:

For: METHOD AND APPARATUS FOR PROCURING GOODS
IN AN AUTOMATED MANNER

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REPLY BRIEF TRANSMITTAL FORM

BOARD OF PATENT APPEALS
AND INTERFERENCES

Assistant Commissioner for Patents
Washington, DC 20231

July 3, 2001

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on May 7, 2001.

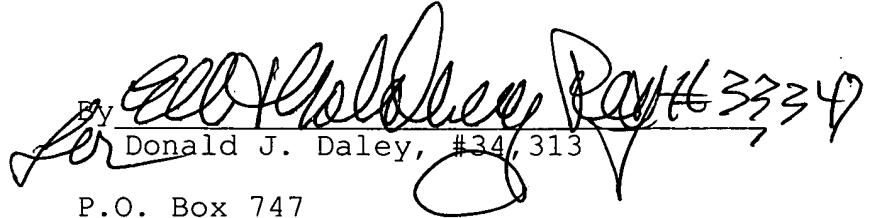
- ☐ An extension of time under 37 C.F.R. § 1.136(b) to _____ was requested on _____ and was approved on _____.
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Appl. No. 08/900,360

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP


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Attachments

(Rev. 01/22/01)

(NE)
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PATENT
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Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

BOARD OF PATENT APPEALS
AND INTERFERENCES

This is a Reply Brief directed to new arguments and to adopt a suggestion of the Examiner presented in the Examiner's Answer mailed May 7, 2001.

DECLARATION

Initially, in the Examiner's Answer in response to a question raised in the Brief regarding dates of the documents used in the rejection (Brief, page 21), the Examiner stated that "the inventor only need to swear back to at least December 14, 1995 to overcome the disclosure of the Internet embodiment of source interactive software." (Answer, page 23)

Initially, an examination of this reference at best only establishes that IBNL (the company) referred to in reference X existed on December 14, 1995.

There is nothing in the W reference that indicates that the disclosure of the X

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reference was known or described. Certainly, the W reference although referring to software, this software certainly could be something other than what was disclosed in the X reference. Furthermore, the validity of the totality of these two references has not established that actually the users knew about the system. This was addressed in the Brief and the arguments are not repeated here.

Furthermore, enclosed and attached to this Reply Brief is a Declaration to swear behind the W reference as newly suggested by the Examiner in the Examiner's Answer. (Answer, page 23)

Also, in the Answer, the Examiner again questions what the word "from January 10, 1999" means. (Paragraph bridging pages 21 and 22 of the Office Action). Evidence was presented in the Brief as to what the word "from" means. (Brief, page 20, last paragraph and page 21, first paragraph). The Patent Office should have commented on this evidence. See MPEP § 1208(11) at page 1200-16. Also, the Patent Office has presented no new evidence to rebut the evidence provided in the Brief. Accordingly, no further argument is made on this point.

This Declaration together with the other Declarations submitted (copies attached to the Brief) establishes at least that the Applicant conceived the context claimed before December 14, 1995 and was diligent before a reduction to practice. Accordingly, in view of the Declarations, the rejection has been overcome.

Grouping of Claims

In the Answer on page 3 (Section 7), the Examiner asserted that claims 1-20 stand or fall together. In the Brief, the claims were grouped as set forth in item X on page 10 of the Brief. Also, separate arguments were made to the claims on pages 14 and following of the Brief. In fact, in the Examiner's Answer, arguments were made to the separate claims (starting on page 13 of the Answer).

In summary, the Applicant has complied with the provisions of 37 C.F.R. §§ 1.192(7) and 1.192(c)(8).

Furthermore, the statements presented by the Applicant regarding the separately grouped claims is an argument as to the merits of the claims. See In re Beaver, 893 F.2d 329, 13 USPQ2d. 1409 (Fed. Cir. 1989) wherein the court stated as follows:

The public responsibility of the Patent and Trademark Office requires attentive performance of all aspects of the patent examination function. The Office is charged with the duty of examining the claims contained in the patent application, including review by the Board when appeal is taken under 35 U.S.C. § 134. It is not only unfair to the applicant, it is also inefficient to decline to review claims that are properly appealed and reasonably argued before the Board. (emphasis added)

Additionally, a Petition regarding the Grouping of Claims has been separately presented in the event the Patent Office wishes to resolve this matter by administrative review.

Accordingly, the Examiner is requested to withdraw the statement that claims 1-20 stand or fall together.

**Reply to Response to New and Amplified
Arguments in the Examiner's Answer**

(1) On page 5 of the Answer (Section 11), there was a statement that although all the references cited in the preamble of the rejection were not explicitly referenced in the body of the rejection, they all still contribute to the product description and therefore are valid support references. Initially, as discussed in the Brief, which will not be repeated here, the references that do not have an effective date (see VIII, starting on page 5, of the Brief) are not competent evidence. While it is recognized in very limited situations, references that have a later date can be used, this is not the situation here. See MPEP § 2124. Also, the Patent Office has presented no legal authority to support its position.

At best, the documents cited which have an ineffective date only refer generally to IBNL and are not competent evidence with respect to the text of the "X" reference.

(2) On page 8 of the Examiner's Answer, it was stated that the Salmon reference, as it ranks the product, inherently ranks the seller. While it is recognized as pointed out in the Answer that inherency (implicit) can be used in a rejection under 35 U.S.C. § 103, (MPEP § 2112) inherency may not be based on probability or possibility. See Continental Can Co. USA, Inc. v. Monsanto Co., 20 USPQ2d. 1746, 1749 (Fed. Cir. 1991) wherein the court stated as follows:

Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may

result from a given set of circumstances is not sufficient

While the above case related to anticipation based on the facts here it applies here. The Patent Office has not met its burden of proof for inherency.

Additionally, the ranking of sellers is not the same or equivalent to ranking the buyers. That is, in ranking the sellers certain criteria of the sellers must be set forth such as their location and their record of service (see, for example, the Specification, for example, page 4, fourth full paragraph, page 5, lines 4-5, page 14, first full paragraph, and page 16, line 10 to page 17, line 7).

(3) On page 10 of the Answer, the cases of In re Fine and In re Jones were cited. While the statement regarding these two cases is correct, a review of these cases indicates that even with this statement of the cases the Patent Office was reversed with respect to rejections under 35 U.S.C. § 103, which should parallel the finding in this application.

(4) With respect to the references not discussed in a rejection, while the Answer states that while these documents were not explicitly referenced in the body of the rejection, they all still contribute to the product description and therefore are valid supporting references (Answer, page 5).

As the references are not discussed in the rejection, actually they offer no valid evidence under U.S. patent law.

(5) With respect to the argument regarding base claim 10, it is the position in the Answer that the Appellant admits that claims 10-18 "recite a system which is related to the method. Therefore, the rejection of claims 1-9 (the corresponding method claims) is applicable to the claims 10-18 as well."

A review of claim 10, while it is related to the method of claim 1, reveals that it recites means which includes the means set forth in the Specification, which is not a requirement, for example, of method claim 1.

(6) On page 7 of the Examiner's Answer, the statement was made "Appellant has failed to adequately challenge the Examiner's *prima facie* case: that, therefore, references U(2) and V(2) are asserted to be valid references."

The Appeal Brief does establish that the Appellant timely traversed that no *prima facie* case of obviousness was established. See page 12 and 13 of the Brief. Therefore, the Appellant relies on the previous statements in the Brief regarding a lack of a *prima facie* case of obviousness.

(7) On page 9 of the Examiner's Answer, there was a question regarding the word "selecting". The Appellant relies on the common definition of selecting, but relies on the totality of the phrase "selecting sellers with the relatively highest ranking." (underline added) Claim 1(f) and Claim 10 "computation means . . . for selecting sellers with the relatively highest ranking."

That is, what was stressed in at least in these two claims was that the selection was of sellers with the relatively highest ranking. The same general comment applies to claim 19, although in that claim the word "providers" was used in place of sellers.

(8) The Examiner asserts, for example, on page 13 of the Answer that claims 2, 3, and 4 (separately argued) state that the patentability of these claims "seems to lie in the novelty of claim 1".

The Appellant is relying on the combination as a whole. That is, claim 2 as it incorporates the subject matter of claim 1 is also patentable for its own recitation. See, for example, In re Sponnoble, 160 USPQ 237 (CCPA 1969) wherein the court stated as follows:

A patentable invention within the ambit of 35 U.S.C. § 103, may result even if the inventor has in effect merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use.

For example, in claim 2, while a computer has been used, it is the total combination that presents the patentability of claim 2.

For the reasons set forth in the original Brief and this Reply Brief, it is requested that the holding of obviousness of the claims be reversed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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